UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,389	04/09/2001	Andreas Hartinger	1140668-0037	1707

7470   7590   06/27/2007
WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER
SHAW, YIN CHEN

ART UNIT	PAPER NUMBER
2135	

MAIL DATE	DELIVERY MODE
06/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 April 2007</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>10-29</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>10-29</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>04/26/2007</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1. This Office Action is responding to the Request for Continued Examination (RCE) dated on 04/24/2007.

2. Claims 10-29 have been submitted for examination.

3. Claims 10-29 have been examined and rejected.

4. Claims 10-29 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 10-16, 19, 21-22, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoch et al, US Patent No. 6460140B1, hereinafter "Schoch" in view of Paolini et al., US Patent No. 6847948B1, hereinafter "Paolini" and Mahin et al., US Patent No. 5,761,719, hereinafter "Mahin".

As per claims 10 and 26-28:

Schoch discloses "A method for controlling authorization to use a software component of a computer system, the method comprising the steps of:

accessing a unique hardware identification code from a computer-readable data medium associated with the computer system, the code accessed from a portion of the data medium that is readable but not writeable" in (Col 4: 16-29);

"accessing license information for the software component" in (Col 3:48-55);

"generating an identification number (license key) comprises the hardware identification code (SID) and the license information (PID)" in (Col 4:1-15, and Col 4: 33); and

"transmitting the identification number to the computer system on which the software component runs" in (Col 4: 1-15);

"whereby authorization to use the software component is allowed for the computer system associated with the computer-readable data medium and not allowed for a second computer system not associated with the computer-readable data medium having the unique hardware identification code accessed from a portion of the data medium (SID = "microprocessor ID", a second computer system will have another unique "microprocessor sector ID")" in (Col 4: 1-15 and Col 4:20-29).

Schoch further discloses the limitation regarding by means of an encoding algorithm as an encryption algorithm (Col 4: 8-11 and Col 4: 33-36).

Schoch does not expressly disclose "wherein the encoding algorithm inputs comprises the hardware identification code and the license information". However, Paolini discloses "the encoding algorithm inputs comprises the hardware identification code and the license information" as combining the inputs of the unique hardware device ID and the license number/serial number of the program (i.e., generating the identification information by combining/converting the information of the two inputs in any manner) (Col 5: 29-33 and Col 6: 26-32). In addition, Mahin et al. disclose that the (processor) identification information is stored in the ROM (read-only memory) as the limitation of the medium that is readable but not writeable (Col 5: 6-9).

Schoch, Paolini, and Mahin are analogous art because they are from similar technology relating to the digital data information security and data accessing. It would have been obvious to one of ordinary skill in the art at the time of invention was made to combine Schoch, Paolini, and Mahin since one of ordinary skill in the art would be motivated to (1) prevent an unauthorized computer system from operating or utilizing software or data (Col 1: 52-55 from Paolini) and (2) identify on-chip the cachability of a processor (Col 2: 21-22 from Mahin). Therefore, it would have been obvious to combine Schoch, Paolini, and Mahin to obtain the invention as specified in claims 10 and 26-28.

As per claim 11:

Schoch, Paolini, and Mahin disclose "The method according to claim 10, wherein additional information is used by the encoding algorithm to generate the identification number" in (Col 4: 1-15 from Schoch, the optional information).

As per claim 12:

Schoch, Paolini, and Mahin disclose "The method according to claim 10, wherein a plurality of identification numbers can be generated for one hardware identification code" in (Col 4: 1-15) (license key = Encrypt (Product ID + System ID from Schoch) for each software license can be generated uniquely according to the variables in the equation).

As per claim 13:

Schoch, Paolini, and Mahin disclose "The method according to claim 10, wherein at least one identification number is stored in a readable and writeable area of the data medium" in ((Col 4: 1-15 from Schoch (the registration library receives the license key and stores it on the user's computer) or (Col 5: 6-9 from Mahin)).

As per claim 14:

Schoch, Paolini, and Mahin disclose "The method according to claim 10, wherein additional information (a data medium can store program software, registration information, and so far) may be stored on the data medium" in (Col 3:17-33 from Schoch).

As per claim 15:

Schoch, Paolini, and Mahin disclose "The method according to claim 14, wherein the additional data stored on the data medium comprises at least one element selected from the group consisting of license information, licensor identification, and software programs" in (Col 3:17-33 from Schoch).

As per claim 16:

Schoch, Paolini, and Mahin disclose "The method according to claim 10, wherein the data medium comprises a component of the computer system" in ((Col 3:17-33 from Schoch) or (Col 5: 6-9 from Mahin)).

As per claim 19:

Schoch, Paolini, and Mahin disclose "The method according to claim 10, wherein the data medium comprises a key which contains information" in ((Col 3:17-33 from Schoch) or (Col 5: 6-9 from Mahin)).

As per claim 21:

Schoch, Paolini, and Mahin disclose "The method according to claim 10, wherein the computer system comprises a control unit" in (Col 4:20-29 from Schoch).

As per claim 22:

Schoch, Paolini, and Mahin disclose "The method according to claim 10, wherein the identification number is checked by means of a decoding algorithm" in (Col 4: 1-15, and Col 4: 33 from Schoch).

As per claim 25:

Schoch discloses "A method for controlling authorization to use a software component of a computer system, the method comprising the steps of:

accessing a unique hardware identification code from a computer-readable data medium associated with the computer system, the code accessed from a portion of the data medium that is readable but not writeable" in (Col 4: 16-29);

"accessing license information for the software component" in (Col 3:48-55);

"generating an identification number (license key) comprises the hardware identification code (SID) and the license information (PID)" in (Col 4:1-15, and Col 4: 33); and

transmitting the identification number to the computer system on which the software component runs" in (Col 4:1-15);

"checking the identification number by means of a decoding algorithm; and

fl. if the decoded identification number matches the encoded information,

permitting a user to utilize the software component; or

f2. if the decoded identification number does not match the encoded information,

restricting the user from access to the software component (Col 4:1-15);

whereby authorization to use the software component is allowed for the computer

system associated with the computer-readable data medium and not allowed for

a second computer system not associated with the computer-readable data

medium having the unique hardware identification code accessed from a portion

of the data medium that is readable but not writeable (SID = "microprocessor ID",

a second computer system will have another unique "microprocessor sector ID")"

in (Col 4: 1-15 and Col 4:20-29).

Schoch further discloses the limitation regarding by means of an encoding

algorithm as an encryption algorithm (Col 4: 8-11 and Col 4: 33-36).

Schoch does not expressly disclose "wherein the encoding algorithm inputs

comprises the hardware identification code and the license information".

However, Paolini discloses "the encoding algorithm inputs comprises the

hardware identification code and the license information" as combining the inputs

of the unique hardware device ID and the license number/serial number of the

program (i.e., generating the identification information by combining/converting

the information of the two inputs in any manner) (Col 5: 29-33 and Col 6: 26-32).

In addition, Mahin et al. disclose that the (processor) identification information is stored in the ROM (read-only memory) as the limitation of the medium that is readable but not writeable (Col 5: 6-9).

Schoch, Paolini, and Mahin are analogous art because they are from similar technology relating to the digital data information security and data accessing. It would have been obvious to one of ordinary skill in the art at the time of invention was made to combine Schoch, Paolini, and Mahin since one of ordinary skill in the art would be motivated to (1) prevent an unauthorized computer system from operating or utilizing software or data (Col 1: 52-55 from Paolini) and (2) identify on-chip the cachability of a processor (Col 2: 21-22 from Mahin). Therefore, it would have been obvious to combine Schoch, Paolini, and Mahin to obtain the invention as specified in claim 25.

As per claim 29:
Schoch, Paolini, and Mahin disclose "An identifier for use in determining authorization to use a software component of a computer system, the identifier generated according to the method of claim 28" in (Col 4:1-15 from Schoch).

6. Claims 17-18, 20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoch, Paolini, and Mahin in view of Watanabe, US/20020129265.

As per claim 17:
Schoch, Paolini, and Mahin disclose the method of Claim 10. Schoch, Paolini, and Mahin is silent on "wherein the data medium comprises a memory card". Nevertheless, Watanabe discloses the "Method and Apparatus for Managing Software Use" invention, which includes a usage of a dongle to store license information in Para 0005-7).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Schoch, Paolini, and Mahin to include the usage of the Dongle for portability.

As per claim 18:
Schoch, Paolini, Mahin, and Watanabe disclose "The method according to claim 17, wherein the memory card comprises a multimedia card" in (Watanabe, Para 0005-7).

As per claim 20:
Schoch, Paolini, and Mahin disclose the method of Claim 19. Schoch, Paolini, and Mahin is silent on "wherein the key comprises a dongle" Nevertheless, Watanabe discloses the key comprises a dongle in (Watanabe, Para 0005-7).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Schoch, Paolini, and Mahin to include the usage of the Dongle for portability.

As per claim 23:

Schoch, Paolini, and Mahin disclose the method of Claim 10. Schoch, Paolini, and Mahin is silent on "The method according to claim 10, wherein checking for unauthorized use of the software component is performed during startup of the software component".

Nevertheless, Watanabe discloses the "Method and Apparatus for Managing Software Use" invention, which includes a method of checking the license information in the dongle prior executing the software in (Para 0024).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Schoch, Paolini, and Mahin to include the method of authorizing the execution of the software in Watanabe's invention to fully the protection of the software usage.

<u>As per claim 24:</u>
Schoch, Paolini, and Mahin disclose the method of Claim 10. Paolini discloses the check is performed periodically as long as the smart card (dongle) is present (Col 6: 49-54 from Paolini). In addition, Watanabe discloses the "Method and Apparatus for Managing Software Use" invention, which includes a method of checking the license information in the dongle prior executing the software in (Para 0024). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Schoch, Paolini, and Mahin to incorporate Watanabe's teaching of authorizing the execution of the software and also modify to check the authorization periodically during the execution of the software to prevent the software from executing without licensed.

Response to Arguments

7. In view of Applicant's amendment, filed on Apr. 24, 2007, to the independent Claims, the new references by Paolini et al., US Patent No. 6847948B1, hereinafter "Paolini" and Mahin et al., US Patent No. 5,761,719, hereinafter "Mahin" have been found and used in combination with Schoch. Please refer to rejections above.

8. Applicant's remark, filed on Apr. 24, 2007, argues that Watanabe does not disclose the limitation that the software component is performed during startup, Examiner respectfully disagrees. Watanabe specifically discloses that checking the license information in the dongle prior executing the software (parag. 0024). That is, during the start up of the software component (prior to the execution of the software component itself), the license information is check for authorization purpose.

9. Applicant's remark, filed on Apr. 24, 2007, argues that Watanabe does not disclose the limitation that checking for unauthorized use of the software component is performed periodically. It is found the citation from Paolini discloses the process of checking as long as (periodically) the smart card (dongle) is present (Col 6: 49-54 from Paolini).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

    a. Barber et al. (U.S. Patent 5,390,297) disclose license management systems and methods allow licenses for a computer program to be available for use at each of a plurality of nodes of a network. If a valid license file at a local node contains an unexpired, available license, a license manager at the local node permits the computer program to be

executed at the requesting local node. If no such license is available in a valid license file at such local node, the license manager searches the other nodes for a valid license file containing an unexpired, available license. In one embodiment, if an unexpired available license is located in a valid license file at a second (or "remote") node, the license manager transfers such license to the local node, and assigns and encrypts a unique identification to such transferred license. The original record of the transferred license is modified by erasing it from the license file at the remote node so that the transferred license is no longer available there. In a second embodiment, the license manager modifies the license file to indicate use of the license at the local node without such transfer. The number of copies of the computer program that are authorized for execution simultaneously on the network is thus limited to the number of licenses that have been loaded into the license files on the network.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yin-Chen Shaw whose telephone number 571-272-8593. The examiner can normally be reached on 9-6 (M-F).
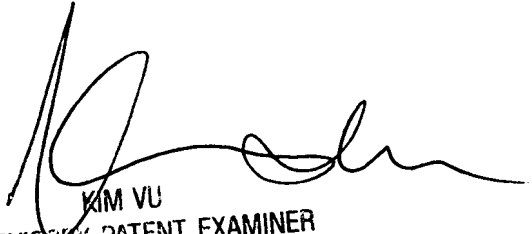
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Y.C. Shaw

Jun. 21, 2007

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100